

REMARKS / ARGUMENTS

Reconsideration of the application is requested.

Claims 1-3, 6-15, 18-19, and 21-22 remain in the application.

Claims 4-5, 16-17, and 20 have been cancelled.

In item 2 on page 2 of the above-identified Office action, claims 2, 8, and 14 have been rejected as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that in claims 2 and 14, it is not clear as to what structural limitation is intended by "a fold." The Examiner has also stated that in claim 8, the language of the claim is directed to method of making which renders the claim vague and indefinite as it is unclear as to what structural limitation applicant is attempting to recite.

According to the definition in Merriam-Webster On-line Dictionary, "a fold" is a part doubled or laid over another part, or something that is folded together or that enfolds. It clearly defines a structure rather than a method of making.

With regard to claim 8, the language "said compensating layer is circumferentially wound at least once around said honeycomb

element" clearly recites a structure rather than a method of making. The word "wound" describes the state of being wrapped around the honeycomb element, rather than the step of winding. This kind of language is commonly used in patent practice. The Examiner is requested to consult with his supervisor before making any further rejections with regard to this matter.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved.

In item 4 on pages 3-4 of the above-mentioned Office action, claims 1-3, 7-8, 12-15, and 19 have been rejected as being anticipated by Locker et al. (US Pat. No. 6,077,483) under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, inter alia:

compensating layer disposed between said casing and said honeycomb element and wound around said honeycomb element, said compensating layer including:

a swelling mat with border regions at risk from abrasion;

an insulating mat having a border and an inner region;

said border of said insulating mat having a thicker region at least at one end of said honeycomb element than at said inner region.

Claim 12 calls for, inter alia:

an insulating mat with a border and an inner region, said inner region having a given thickness and said border of said insulating mat being thicker than said inner region at least in parts thereof.

According to Locker et al., a thermal barrier coating is disposed on the outer cylinder surface of the support. The coating includes an adherent porous refractory ceramic layer, wherein the term "ceramic" is used in the sense to encompass glass, semi-crystalline ceramics such as glass-ceramics, and conventional crystalline ceramics substantially free of glassy phases (see column 2, lines 22-27).

In view of the characteristics of the coating, Locker et al. point out that the adherent isolative barrier coatings are at least as effective as prior art refractory fiber mat coatings in reducing heat transfer from the substrate to the substrate enclosure or to intumescent mat materials lining the enclosure. Moreover, they shall be much more durable, and provide a rigid rather than resilient base against which the exterior intumescent mat layer may more efficiently apply retention pressure. Thus, these coatings shall avoid the problem of fiber mat degradation and shall decrease the likelihood of substrate slippage during use. See column 3, lines 39-48 of Locker et al. Therefore, even Locker et al. recognized the differences between a rigid thermal barrier coating and an insulating mat.

A "mat" generally means a piece of course, woven, plated fabric. Normally, such a mat is flexible, windable, foldable, compressible, and so on. Most of these characteristics also apply to an insulating mat. Therefore, the insulating mat also inherently has the ability of damping and resilience, which further supports the function of the swelling mat. This behavior is completely different from the coating of Locker et al.

Further, Locker et al. state that the barrier coatings are generated upon heat treatment, in particular by a sintering heat treatment (see column 4, lines 28-34). Therefore, there is a large bonding surface and at least partially no separate surfaces exist between the coating and the substrate.

In contrast to the above described connection between the coating and the substrate, the invention of the instant application teaches simply the insulating mat being wrapped or wound around the honeycomb element. This means that there are well-defined surfaces of each component that already lower the heat transfer. Moreover, gaps or similar cavities may occur between the honeycomb element and the insulating mat so that the contact surface of both components is reduced and the enclosed air further reduces the heat transfer. These are further structural differences between the invention of the instant application and Locker et al.

In connection with the above described characteristics of the insulating mat according to the invention of the instant application, the over-all damping characteristic and insulating characteristic of the compensation layer is increased. Moreover, winding an insulating mat around the honeycomb body is easier to carry out so that the time for manufacturing is lowered as well as the resulting costs. In

addition, the insulating mat can be more easily fitted to the finally existing space between the casing and the honeycomb element because of its flexible nature. This also leads to a better protection of the swelling mat because the tolerances of the casing, the honeycomb body, or the swelling mat can be easily overcome by folding the mat accordingly.

Clearly, Locker et al. do not show an insulating mat as recited in claims 1 and 12 of the instant application.

Claims 1 and 12 are, therefore, believed to be patentable over Locker et al. and since all of the dependent claims are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In item 8 on page 5 of the above-mentioned Office action, claims 6 and 18 have been rejected as being unpatentable over Locker et al. in view of Ten Eyck (US Pat. No. 4,999,168) under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 6 and 18 are dependent on claims 1 or 12, they are believed to be patentable as well.

In item 9 on pages 5-6 of the above-mentioned Office action, claims 9-11 and 21-22 have been rejected as being unpatentable over Locker et al. in view of Santiago et al. (US Pat. No. 4,344,922) and Ten Eyck under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 9-11 and 21-22 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-3, 6-15, 18-19, and 21-22 are solicited.

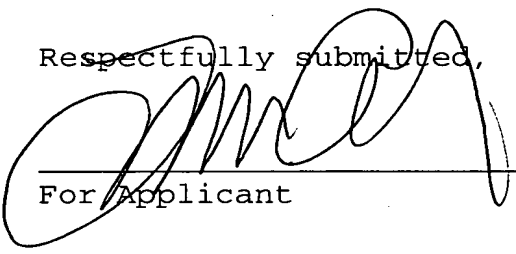
It is also noted that the reference Locker et al. is based on a provisional application and the subject matter relied upon by the Examiner may not be present in that application. The non-provisional application was filed after Applicant's priority date of February 3, 1998.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out. Any Examiner's suggestion with regard to the amendment of the language of the claims would be very appreciated.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to 37 CFR Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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